

IPW

Docket No.: 1293.1173

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Young-min CHEONG et al.

Serial No. 09/764,158

Group Art Unit: 2651

Confirmation No. 7623

Filed: January 19, 2001

Examiner: Ali NEYZARI

For: OPTICAL HEAD FOR NEAR-FIELD RECORDING AND REPRODUCTION, AND
METHOD OF MANUFACTURING THE SAME

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed January 10, 2005, having a shortened period for response set to expire on February 10, 2005. The following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect **Group I, claims 1-48 and 53-59**, in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

The Examiner asserts that the inventions I and II are related as combination and subcombination. The Examiner further asserts that the combination as claimed does not require the particulars of the subcombination as claimed. As noted in the MPEP section 806.05(c), referenced by the Examiner, the inventions are distinct if it can be shown that "the combination claimed does not require the particulars of the subcombination as claimed **for patentability, and** that the subcombination has utility by itself or in other combinations. The Examiner appears to be reading the MPEP 806.05(c) requirement as ""the combination claimed does not require the particulars of the subcombination as claimed for patentability, **or** that the subcombination has utility by itself or in other combinations."

In the present application, no claims for a combination including the subcombination

have been indicated as being allowable; thus, it has not been shown by the Examiner that the combination does not require the particulars of the subcombination as claimed **for patentability**.

Further, the Examiner's statement that the subcombination has separate utility "such as being used with other devices" does not meet the Examiner's burden "to suggest an example of separate utility," as required by MPEP 806.05(c). "Other devices" is a vague term and is certainly not an example as contemplated by MPEP 806.05(c).

III. Conclusion

In view of the above remarks, the Examiner has not made a proper restriction and that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the present application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

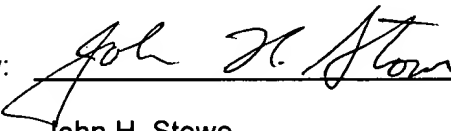
If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number .

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 2/9/05

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